



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/864,905	05/24/2001	Craig Harrison Miller	627-3271P	3099

7590

10/22/2003

Carl B Massey Jr  
Womble Carlyle Sandridge & Rice PLLC  
Post Office Box 7037  
Atlanta, GA 30357

EXAMINER
----------

LIU, HONG

ART UNIT	PAPER NUMBER
----------	--------------

1624

DATE MAILED: 10/22/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Applicati n N .

09/864,905

Applicant(s)

MILLER ET AL.

Examiner

Hong Liu

Art Unit

1624

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.**

Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-4, 6-10, 12-15, 17-25, 27-31, 33-36 and 38-42.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_.

Art Unit: 1624

***Attachment to the Advisory Action***

***Status of the Application***

Applicant response in paper No. 11 is hereby acknowledged. Claims 1-4, 6-10, 12-15, 17-25, 27-31, 33-36, and 38-42 are pending in this application.

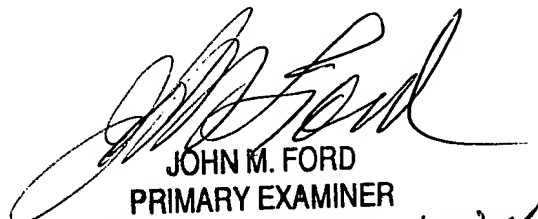
***Response to Arguments***

The request for reconsideration filed on September 22, 2003 under 37 CFR 1.116 in reply to the final rejection has been considered but is not deemed to place the application in condition for allowance and will not be entered. Applicants argue that the reference compounds require an aromatic group or a methyl group at position 22 whereas applicants' instantly claimed compounds are only substituted with hydrogen at that position. The bonding of the nitrogen to hydrogen versus methyl has a significant impact on the binding affinity of the compounds and therefore, the hydrogen substituted compounds have unexpected activities compared to the methyl substituted compounds. The argument is not found very persuasive because there is no teaching in the specification of the superiority of the hydrogen substituted compounds. In fact, in the original claim, R can be both a hydrogen and lower alkyl, suggesting that applicants regard both hydrogen and methyl as equivalents in terms of their chemical properties. In order to show that the hydrogen substituted compounds are indeed superior to the methyl substituted compounds, applicants need to compare side by side the activities of these two classes of compounds. It is insufficient to provide a report that compares the activities of compounds with a substantially different core. In view that the evidence presented by applicants is not sufficient to


Art Unit: 1624

overcome the 103 rejection, the amendments and arguments are not deemed to place the application in condition of allowance.

Any inquiry concerning this communication should be directed to Examiner Hong Liu whose telephone number is (703) 306-5814. If attempts to reach the examiner by the phone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached at (703) 308-4716. The fax phone number for this group is (703) 308-4734 for "unofficial" purposes and the actual number for official business is (703) 308-4556. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose number is (703) 308-1235.

  
JOHN M. FORD  
PRIMARY EXAMINER  
GROUP - ART UNIT 1624

Hong Liu  
October 17, 2003

 Mukund Shah  
Supervisory Patent Examiner  
Art Unit 1624